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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,258	02/17/2004	Shaibal Roy	11783-US-PAT (80238)	3428
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Allen, Dyer, Doppelt, Milbrath & Gilchrist - RIM			EXAMINER	
255 S. Orange Avenue			KHAN, MEHMOOD B	
Suite 1401				
Orlando, FL 32801			ART UNIT	PAPER NUMBER
			2617	
			NOTIFICATION DATE	DELIVERY MODE
			09/02/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/780,258

Applicant(s)

ROY, SHAIBAL

Examiner

MEHMOOD B. KHAN

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/21/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-15,18-27,29 and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-15,18-27,29,31-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 05/21/2009 have been fully considered but they are not persuasive.

Applicant argues on page 11 that "that the claimed system and method downloads the n-most recent mail headers, as compared to Eggleston, which is specifically directed to downloading entire messages (not just the mail headers)".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "not just the mail headers") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant argues on page 17 that "This is not the claimed system and method in which only n-most recent mail headers are passed and if a default order of mail headers cannot be provided, then using the associative information and if that fails downloading all mail headers".

The Examiner would like to point out that Eggleston discloses that mail headers are passed to the addressee with filtering of the message, i.e. default order (**Fig. 6: 604**). Eggleston discloses that the mail is passed to the addressee, thus if the mail is passed to the user then the header is also passed to the user. Eggleston discloses in the flow chart of Fig. 6, and specifically out of decision step 604 which was read as the default order, that if the message size filtering is not applied then the process filters based on text attachments read as associative information (**Fig. 6: 608**). Eggleston

goes on to disclose that if associative information cannot be applied, (**Col 3: 29-34**), where mail that fails the filters can be transferred to the user.

Applicant goes on to argue on pages 17 and 18 that all of the above argued steps are based on determining that if one step cannot be applied moving onto another step and Eggleston does not disclose the above three steps, respectively.

The Examiner would like to state that the determination to move from one step to the next is based on a decision diamond of the flow chart of Fig. 6.

Applicant argues on page 18 that one skilled in the art would not be motivated to combine Eggleston and Lewis.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this instance, Eggleston discloses a system that downloads mail and mail headers to the user. Lewis teaches that a proxy extracts information from a host server to notify the user of existing email. Eggleston does not exclude the use of a proxy to use associative information, such as an ISP domain name, along with header information of the message. Lewis states that use of such information reduces the chances of multiple matching mail identification records (**Col 7: 18-21**). Thus the claimed limitations have been met.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-9, 11-15, 18-22, 24-27, 29, 31-35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Eggleston et al. (US 5,958,066 herein Eggleston).

Claim 1, Eggleston discloses a communications system (**Fig. 2, where Eggleston discloses a communication system**), Eggleston discloses a mobile device having a mail user agent (**Col 5: 16-20, 35-41, where Eggleston discloses a processor in a client (i.e. a mail user agent) for data exchange**); Eggleston discloses a mobile office platform operative with the mail user agent for accessing one or more electronic mailboxes of the mail user agent using at least one protocol specific connector (**Col 5: 42-55, where Eggleston discloses a controller having a Virtual Session Manager (VSM), protocol translators and a post office**), Eggleston discloses wherein said mobile office platform is operative for providing only the n-most recent mail headers of electronic messages to the mail user agent in a default order of mail headers provided by an electronic mail protocol used for accessing an electronic mailbox (**Fig. 6: 604, where Eggleston discloses filtering based on message size i.e. default order**), Eggleston discloses if the default order of mail headers cannot be provided, then providing most recent mail headers in an order based on associative information about an electronic mail provider and/or electronic mailbox to be accessed

(Fig. 6: 608, where Eggleston discloses filtering based on text attachment),

Eggleston discloses if associative information cannot be used, then downloading all message mail headers **(Col 3: 29-34, where Eggleston discloses partial transfers of data that may not have qualified for transfer).**

Claim 3, Eggleston discloses wherein said message header comprises a unique identifier (UID) of an electronic mail message **(Fig. 8: 801, 802, where Eggleston discloses serial numbers and header information).**

Claim 5, Eggleston discloses a database associated with said mobile office platform and containing records of associative information for [electronic mail providers and/or] electronic mailboxes to be accessed **(Fig. 2: 228, 246, where Eggleston discloses a memory for Client mail and mailboxes at the post office).**

Claim 6, Eggleston discloses wherein said associative information comprises the name of the electronic mail protocol used for accessing an electronic mailbox **(Col 5: 59-66, where Eggleston discloses using a translator for data transfer).**

Claim 7, Eggleston discloses wherein said associative information comprises the version of the electronic mail protocol used for accessing an electronic mailbox **(Col 4: 29-35, where Eggleston discloses multiple versions of protocols).**

Claim 8, Eggleston discloses wherein said associative information comprises the name of the electronic mail server **(Col 6: 35-42, where Eggleston discloses client and host identifiers)**.

Claim 9, Eggleston discloses wherein the name of the electronic mail server is applicable to a specific electronic mail protocol used for accessing an electronic mailbox **(Col 6: 35-42, where Eggleston discloses a type of communications involved)**.

Claim 11, Eggleston discloses wherein said mobile office platform is operative for downloading an entire message list for one or more electronic mailboxes **(Col 3: 6-9, where Eggleston discloses a communication server downloading Email)**, Eggleston discloses sorting the message headers, and extracting only the n-most recent mail messages for delivery to a mail user agent that requested electronic mail **(Col 3: 6-9, where Eggleston discloses applying filtering rules, Figs. 5 and 6, where Eggleston discloses rules to apply prior to sending the Email/header)**.

Claim 12, Eggleston discloses wherein said mobile device comprises a wireless device **(Fig. 2: 201, where Eggleston discloses a wireless device)**.

Claim 13, Eggleston discloses wherein said mail user agent is operative for accessing the mobile office platform using a POP [IMAP or webmail] protocol **(Col 4: 58-66, where Eggleston discloses an electronic mail post office)**.

Claim 14, Eggleston discloses wherein said plurality of protocol specific connectors comprise [a POP connector for accessing POP mailboxes, an IMAP connector for accessing IMAP mailboxes, or] a connector for accessing mail from an Exchange server (**Fig. 2: 220, where Eggleston discloses a communication server for transfer of messages from a host to a client**).

Claim 15, Eggleston discloses a communications system (**Fig. 2, where Eggleston discloses a communication system**), Eggleston discloses a server having a mail agent for accessing one or more electronic mailboxes (**Fig. 2: , where Eggleston discloses a communication server**) of a mail user agent using at least one protocol specific connector (**Col 5: 16-20, 35-41, where Eggleston discloses a processor in a client (i.e. a mail user agent) for data exchange, Col 5: 42-55, where Eggleston discloses a controller having a Virtual Session Manager (VSM), protocol translators and a post office**); Eggleston a database associated with the mail agent and containing associative information about an electronic mail provider and/or electronic mailbox relating to the order in which mail headers are stored and/or retrieved from the electronic mailbox (**Fig. 2: , where Eggleston discloses a memory with Client Mail, Col 3: 6-9, where Eggleston discloses applying filtering rules, Figs. 5 and 6, where Eggleston discloses rules to apply prior to sending the Email/header**), Eggleston discloses wherein said mail agent is operative for providing only the n-most recent mail headers of electronic messages to a mail user agent of a mobile device in a default order of mail headers provided by an electronic mail protocol used for accessing an electronic mailbox (**Fig. 6: 604, where Eggleston discloses filtering based on message size i.e. default order**) Eggleston discloses if the default

order of mail headers cannot be provided, then providing most recent mail headers in an order based on associative information about an electronic mail provider and/or electronic mailbox to be accessed (**Fig. 6: 608, where Eggleston discloses filtering based on text attachment**), Eggleston discloses if associative information cannot be used, then downloading all ~~message~~ mail headers (**Col 3: 29-34, where Eggleston discloses partial transfers of data that may not have qualified for transfer**).

Claim 18, as analyzed with respect to the limitations as discussed in claim 3.

Claim 19, as analyzed with respect to the limitations as discussed in claim 6.

Claim 20, as analyzed with respect to the limitations as discussed in claim 7.

Claim 21, as analyzed with respect to the limitations as discussed in claim 8.

Claim 22, as analyzed with respect to the limitations as discussed in claim 9.

Claim 24, as analyzed with respect to the limitations as discussed in claim 11.

Claim 25, as analyzed with respect to the limitations as discussed in claim 13.

Claim 26, as analyzed with respect to the limitations as discussed in claim 14.

Claim 27, Eggleston discloses a method of retrieving electronic mail (**Abstract**) comprising the steps of: Eggleston discloses accessing one or more electronic mailboxes of a mail user agent using at least one protocol specific connector (**Fig. 2: 240, where Eggleston discloses a Post Office server, Col 5: 16-20, 35-41, where Eggleston discloses a processor in a client (i.e. a mail user agent) for data exchange, Col 5: 42-55, where Eggleston discloses a controller having a Virtual Session Manager (VSM), protocol translators and a post office**); Eggleston discloses providing to the mail user agent only the n-most recent mail headers of

electronic mail messages that had been accessed in a default order of mail headers provided by an electronic mail protocol used for accessing an electronic mailbox (**Fig. 6: 604, where Eggleston discloses filtering based on message size i.e. default order**), Eggleston discloses if the default order of mail headers cannot be provided, then providing most recent mail headers in an order based on associative information about an electronic mail provider and/or electronic mailbox to be accessed (**Fig. 6: 608, where Eggleston discloses filtering based on text attachment**), Eggleston discloses if associative information cannot be used, then downloading all ~~message~~ mail headers (**Col 3: 29-34, where Eggleston discloses partial transfers of data that may not have qualified for transfer**).

Claim 29, as analyzed with respect to the limitations as discussed in claim 3.

Claim 31, as analyzed with respect to the limitations as discussed in claim 5.

Claim 32, as analyzed with respect to the limitations as discussed in claim 6.

Claim 33, as analyzed with respect to the limitations as discussed in claim 7.

Claim 34, as analyzed with respect to the limitations as discussed in claim 8.

Claim 35, as analyzed with respect to the limitations as discussed in claim 9.

Claim 37, as analyzed with respect to the limitations as discussed in claim 11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 23 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston in view of Lewis (US 7,240,095).

Claim 10, Eggleston does not explicitly disclose wherein said associative information comprises the domain name of an internet service provider used for accessing electronic mailboxes.

In an analogous art, Lewis discloses wherein said associative information comprises the domain name of an internet service provider used for accessing electronic mailboxes (**Fig. 2: 66, where Lewis discloses a record indicating an ISP**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eggleston to use records in user profiles as taught by Lewis so as to reduce the chances of multiple matching mail identification records (**Col 7: 18-21**).

Claim 23, as analyzed with respect to the limitations as discussed in claim 10.

Claim 36, as analyzed with respect to the limitations as discussed in claim 10.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date

the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MEHMOOD B. KHAN** whose telephone number is (571)272-9277. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B. K./
Examiner, Art Unit 2617

/Lester Kincaid/
Supervisory Patent Examiner, Art Unit 2617